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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,824	11/05/2001	Brian R. Beams	05222.00143	7196
29638	7590	04/18/2006	EXAMINER	
BANNER & WITCOFF, LTD. ATTORNEYS FOR CLIENT NO. 005222 10 S. WACKER DRIVE, 30TH FLOOR CHICAGO, IL 60606			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,824	BEAMS ET AL.	
	Examiner	Art Unit	
	David E. England	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1 – 19 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium **encoded** with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

5. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer

Art Unit: 2143

programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized.

6. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and treated as a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 5 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

9. The limitation of claims 5 and 15 that state, "entering a breakout room" is not disclosed in the specification to enable one of ordinary skill in the art to depict what "a breakout room" is or could be. Furthermore, there is not disclosure that states that the breakout room is an actual room or a virtual room, i.e., the claim language could be interpreted as the computer system

Art Unit: 2143

giving a user the ability to unlock a room that is called the “breakout room”. Also, there is no disclosure as to how one enters said “breakout room”. Applicant is asked to point to the main body of the specification and the drawings to give support for their arguments.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 – 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. In claims 1, 10 and 11, it is recited that “providing a selected virtual university activity type,” which is not specifically stated in the specification as to what “types” of activities are selectable in the virtual university. In the specification there are numerous instances where an “activity” and the “type” it could be. Example, a user can be logging on to the virtual university, therefore the “activity type” would be logging on. This is one interpretation to the claim language out of many and does not limit other interpretations that can be draw from the broad claim language. Applicant is asked to amend the claim language to further bring out the true essence of the claimed invention and to further prosecution.

13. Claims 1, 10 and 11 recite the limitation "the selected virtual activity" in the second to the last line in the claims. There is insufficient antecedent basis for this limitation in the claim. It appears that the Applicant means to state “the selected virtual university activity type”.

14. Claims 2 – 9, and 12 – 19 are rejected for their dependency on the above claims.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1 – 4, 6 – 14 and 16 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisendrath et al. (6347333) (hereinafter Eisendrath) in view of Podgorny et al. (6078948) (hereinafter Podgorny).

17. Referencing claim 1, as closely interpreted by the Examiner, Eisendrath teaches a method for establishing a virtual university, comprising the steps of:

18. connecting a virtual university server and one or more users, (e.g. col. 1, line 65 – col. 2, line 9);
19. selecting a destination within the virtual university server to interact with the one or more users, (e.g. col. 6, lines 27 – 35);
20. coupling the one or more users through the virtual university server based on the selected destination, (e.g. col. 5, lines 50 – 58), but does not specifically teach establishing interaction parameters for the one or more users based on the selected destination; and

Art Unit: 2143

21. providing a selected virtual university activity type based on the interaction parameters and the destination, the selected virtual activity type being one of a plurality of virtual university activity types.

22. Podgorny teaches establishing interaction parameters for the one or more users based on the selected destination, (e.g. col. 9, line 38 – col. 10, line 30); and

23. providing a selected virtual university activity type based on the interaction parameters and the destination, the selected virtual activity type being one of a plurality of virtual university activity types, (e.g., col. 7, lines 14 – 38 & col. 9, line 38 – col. 10, line 30).

24. It would have been obvious to one of ordinary skill in the art, at the time the invention was conceived, to combine Podgorny with Eisendrath because it would be more efficient for a system if the student identified themselves so to access information that could be private to only that or other specific students that have specific rights to the private information.

25. Referencing claim 2, as closely interpreted by the Examiner, Eisendrath teaches the destinations include a virtual student union where users can interact using a bulletin board or other collaborative functions, (e.g. col. 7, lines 18 – 24).

26. As per claim 3, as closely interpreted by the Examiner, Eisendrath teaches the destinations include a virtual library where a user can user resources and consult with a virtual librarian, (e.g. col. 2, lines 36 – 54).

Art Unit: 2143

27. As per claim 4, as closely interpreted by the Examiner, Eisendrath teaches the destinations include a virtual administration office where a user can register for courses, search a directory, utilize a class locator, consult with the administration help desk, (e.g. col. 7, lines 18 – 24),

28. add a course, (e.g. col. 2, lines 23 – 35), drop a course, (e.g. col. 7, line 66 – col. 8, line 12), and utilize a career center, (e.g. col. 1, line 65 – col. 2, line 9).

29. As per claim 6, as closely interpreted by the Examiner, Eisendrath teaches the destinations include a university directory that provides information on persons and entities associated with the university, (e.g. col. 6, lines 27 – 35).

30. As per claim 7, as closely interpreted by the Examiner, Eisendrath teaches tests are applied to the users, (e.g. col. 7, lines 1 – 10).

31. As per claim 8, as closely interpreted by the Examiner, Eisendrath teaches any two users can collaborate in the virtual university, (e.g. col. 8, lines 13 – 20 & col. 10, lines 56 – 60).

32. As per claim 9, as closely interpreted by the Examiner, Eisendrath teaches grades are distributed electronically, (e.g. col. 7, lines 34 – 42).

33. Claims 10 – 14 and 16 – 19 are rejected for similar reasons as stated above.

Art Unit: 2143

34. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisendrath and Podgorny as applied to claim 1 above and, in further view of what is well known in the art.

35. As per claim 5, as closely interpreted by the Examiner, Eisendrath teaches the destinations include a virtual classroom where a user can learn, (e.g. col. 5, lines 50 – 58 & col. 6, lines 3 – 19),

36. view a directory of other students in a current class, (e.g. col. 7, lines 43 – 57),

37. view materials, (e.g. col. 9, lines 57 – 63),

38. grades, (e.g. col. 8, lines 31 – 52),

39. announcements, (e.g. col. 8, lines 31 – 52),

40. homework, (e.g. col. 9, lines 57 – 63),

41. administer tests, (e.g. col. 7, lines 1 – 10),

42. ask questions of an instructor, (e.g. col. 7, lines 18 – 24),

43. review lectures, (e.g. col. 7, lines 18 – 24),

44. view the class schedule and view research topics, (e.g. col. 7, line 66 – col. 8, line 12 & col. 10, lines 27 – 36), but doesn't specifically teach enter a breakout room, review old tests.

45. Podgorny teaches a breakout room, (e.g. col. 5, lines 9 – 19). It would have been obvious to one of ordinary skill in the art, at the time the invention was conceived, to combine Podgorny with Eisendrath because letting students interact in other manners that does not require academic activities on the same program that has a plurality of different academic amenities allows a user

Art Unit: 2143

to stay on the same web site and not have to log off and log onto the system again to find other means to break from academic work.

46. Podgorny does not specifically teach review old tests.

47. Although, Eisendrath and Podgorny do not specifically teach reviewing old tests, Eisendrath does state that an instructor and/or a user can post documents on the system for other users to view. It would be obvious that if a user can post any type of documents on the system, then the user can post documents like homework, events that are coming up, syllabus, current student enrolment and even old tests for studying. An old test is just a label for a document, it has no special coding or configuring that would differentiate it from other types of documents that can be posted, (like homework or a syllabus).

48. Therefore, Examiner takes Official Notice (see MPEP § 2144.03) that " review old tests " in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states

Art Unit: 2143

"Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

49. Claim 15 is rejected for similar reasons as stated above.

Response to Arguments

50. Applicant's arguments filed 09/12/2005 have been fully considered but they are not persuasive.

51. In the Remarks, Applicant argues in substance that the patent application states what a breakout room is and provides logic in Figure 89 for accessing a breakout room (corresponding to function block 89310). The corresponding description is provided from page 203, line 17 to page 204, line 7. Therefore, the rejection is to be withdrawn. Furthermore, Applicant cites the an IDS titled "Meetings: Do's, Don'ts and Donuts teach what a breakout rooms are for and breakout groups, therefore it is well known in the art.

52. As to part 1, there is not disclosure in the specification that teaches what would constitute a breakout room nor is there any information in the specification that would make a breakout room unique or any different than another chat room. The specification only mentions that there is a "breakout room".

53. Furthermore, Applicant has admitted that the "breakout room" is well known in the art by giving the prior art in an IDS, therefore Applicant has submitted that a "breakout room" not

Art Unit: 2143

novel and was already taught by the prior art of record as interpreted in light of the 112 rejection above.

54. Also, it is brought to the Examiner's attention that the prior art cited in the IDS Does Not take place in a network. Which would make one believe that the Examiner's interpretation of a breakout room being physical and not in a network or chat room correct and that the Applicant means to give a user access to a physical room by some means, which also isn't stated in the specification as to how this would happen.

55. In the Remarks, Applicant argues in substance that the combination of Eisendrath and Podgorny does not suggest the feature taught in claim 1, emphasis added, "providing a selected virtual university activity type based on the interaction parameters and the destination, the selected virtual activity type being one of a plurality of virtual university activity types" and "current classes".

56. As to part 2, Examiner would like to draw the Applicant's attention to the newly stated 112 rejections so that the Applicant can take steps to clarify the limitations of the claimed invention as it is now interpreted. Furthermore, in regards to the limitation of "current classes", the Applicant is asked to draw their attention to the newly rejected limitation and reasoning, i.e., the Instructor and/or a user can post any document they wish on the board, therefore the Instructor can post a roster of all the students or users that participate in the current class since in is well known in the art that all Instructors can have a roster of the people that are taking their class.

Art Unit: 2143

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
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